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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,708	04/30/2001	James R.H. Challenger	YOR9-2001-0281US1 (8728-5)	2686
46069 7590 04/23/2008 F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797				
EXAMINER PAULA, CESAR B				
ART UNIT 2178		PAPER NUMBER		
MAIL DATE 04/23/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/845,708

**Applicant(s)**

CHALLENGER ET AL.

**Examiner**

CESAR B. PAULA

**Art Unit**

2178

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16, 17, 19-21, 24 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 19-21, 24 and 32-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-884)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_



### **DETAILED ACTION**

1. This action is responsive to the amendment filed on 2/4/2008.

**This action is made Final.**

2. In the amendment, claims 35-38 have been added. Claims 16-17, 19-21, 24 and 32-38 are pending in the case. Claims 16, and 35 are independent claims.

### ***Drawings***

3. The drawings filed on 4/30/2001 have been approved by the examiner.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-17, 19-21, and 32-34 remain, and claims 35-36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky (US Pub.# 2003/0190054 A1, 10/9/2003, Provisional application filed on 10/3/2000), in view of Lewis, R., "Adobe Pagemill 2.0 Handbook", hereinafter Pagemill Hayden Books, 1996, pages 138-143, and chapter 1, and further in view of Levy et al, hereinafter Levy (USPub 2003/00112548 A1, 1/16/2003, provisional application filed on 12/21/2000).

Regarding independent claim 16, Troyansky teaches inserting or storing a digital watermark into digital content *--determining a content creation preference--* by replacing or converting parts of digital files, such as HTML files—*electronically encoded HTML textual document--* with hidden images--*watermarks--* such as image (0003). In other words parts of the text of the HTML files are extracted, and then watermarked by dynamically converting those HTML parts, which are in a textual format ( as is well known, and shown by Pagemill below), into an image.

Furthermore, Troyansky fails to explicitly disclose: *receiving a request for the textual content from a client; obtaining, at a server, the textual content in text format, automatically by the server; replying to the request by serving the HTML document containing the inline reference to the stored textual content in the image format, wherein the reply does not include the textual content in the image format.* However, Pagemill teaches an Internet server receiving a request for a tagged HTML file. In response, the Internet server communicates the HTML file in textual format to a requesting client computer. The images are treated as text by the HTML format (page 12, parag.3-page 13, page 18-20). Levy teaches a server adding, and dynamically linking of a watermarked image, from a database, to a web page at the time of rendering the web page, by adding the link to that image on the web page (0094, last 8 lines)—*generating an HTML containing an inline reference to the stored textual content in the image format for retrieval and dynamic assembly by the client.* It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Pagemill, and, Levy because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting

watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 17, which depends on claim 16, Troyansky teaches inserting a digital watermark into digital content by replacing or converting parts of digital files, such as HTML files, which are in a textual format (as is well known, and shown by Lemay, page 112, lines 15-36), with hidden images--*watermarks*--such as image (0003). In other words parts of the text of the HTML files are extracted, and then watermarked by dynamically converting those HTML parts into an image.

Regarding claim 19, which depends on claim 16, Troyansky teaches compressing a watermark using lossy compression algorithms--*watermarking preference* (0004, lines 6-9).

Regarding claim 20, which depends on claim 19, Troyansky teaches compressing a watermark using lossy compression algorithms--*compression preference* (0004, lines 6-9).

Regarding claim 21, which depends on claim 16, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files (0003). Troyansky fails to explicitly disclose: *the mapping preference relates selectable spatial display coordinates to external document identifiers in order to enable user navigation*. However, Pagemill teaches inserting an active image, which contains more than one URL. The image is divided into areas, setup by coordinates along with their associated URLs. When a user clicks on an area, the browser jumps to the URL--*external document identifier*-- of the respective area

(page 139, lines 21-33, and fig. 6.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Troyansky, Takashi, Lemay, Truong, and Pagemill, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting data in the HTML document from unauthorized use.

Regarding claim 32, which depends on claim 16, Troyansky fails to explicitly disclose: *the content creation preference specifies attributes of the textual content in image format.* However, Levy teaches adding spaces at the end of text in a watermark(0098)—. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, and Levy, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 33, which depends on claim 16, Troyansky fails to explicitly disclose: *the attributes of the textual content in image format include at least one of font, font size, color, and margins.* However, Levy teaches adding spaces at the end of text in a watermark(0098)—. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, and Levy, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 34, which depends on claim 16, Troyansky fails to explicitly disclose: *receiving a request from the client, for the textual content in the image format according to the inline reference, wherein the inline reference is a URL, and replying to the request from the client for the textual content in the image format.* However, Pagemill teaches the Internet server communicates the HTML file in textual format to a requesting client computer. The images are treated as text by HTML format (page 12, parag.3-page 13, page 18-20). The images are loaded from the server after the html text is received and parsed. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Pagemill, and Levy, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding independent claim 35, all the limitations are similar to limitations found in claim 16, and therefore are likewise rejected, except for *storing the textual content in the image format as a uniquely addressable element identified by a Uniform Resource Locator (URL)*, which is taught by Pagemill's Internet server receiving a request for a tagged HTML file. In response, the Internet server communicates the HTML file in textual format to a requesting client computer. The images are treated as text by the HTML format, and are referred to by addresses to locations where the images are individually found (page 12, parag.3-page 13, page 18-20). Levy teaches a server adding, and dynamically linking of a watermarked image, from a database, to a web page at the time of rendering the web page, by adding the link to that image on the web page (0094, last 8 lines)—*generating an HTML containing an inline reference to the stored*



*textual content in the image format for retrieval and dynamic assembly by the client.* It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Pagemill, and, Levy because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Claims 36, and 38 are directed towards the steps found in claims 19-20, and therefore are similarly rejected.

6. Claims 24 remains, and 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Pagemill, further in view of Levy, and further in view of Minematsu (Pat.# 6,700,993, 3/2/2004, filed on 9/6/2000).

Regarding claim 24, which depends on claim 19, Troyansky teaches inserting a digital watermark into digital content by replacing or converting parts of digital files, such as HTML files such as image (0003). Troyansky fails to explicitly disclose: *receiving a client system request for verification of the watermarked content.* However, Minematsu teaches a user terminal transmitting first transmission of watermarked information to a detection center, where the information is authenticated. The information is then transmitted to the user terminal, where the authentication result is displayed (col.3, lines 61-col.4, line 67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Pagemill, Levy, and Minematsu, because Minematsu teaches providing a tamper resistant

watermarked image for encrypting information (col. 3, lines 57-67). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Claim 37 is directed towards the steps found in claim 24, and therefore is similarly rejected.

### ***Response to Arguments***

7. Applicant's arguments filed 2/4/2008 have been fully considered but they are not persuasive in view of the rejections above.

In response to applicant's arguments against the references individually (pages 7-8), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Pagemill teaches an Internet server receiving a request for a tagged HTML file. In response, the Internet server communicates the HTML file in textual format to a requesting client computer. The images are treated as text by the HTML format (page 12, parag.3-page 13, page 18-20). In other words the reply, which the server sends to the browser, only includes the html textual code, and not the watermarked image as recited in the independent claims 16, and 35.

Claims 17, 19-21, 32-34, and 36-38 are dependent on the independent claim, and therefore are rejected at least based on the rationale found above.

*Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hirayama et al. (Pat. # 6,782,509 B1), and Simpson et al. (Pat. # 6,900,905 B2).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, please call 800-786-9199 or 571 272-1000 (USA or Canada).

Any response to this Action should be mailed to:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

- **(571)-273-8300** (for **all** Formal communications intended for entry)

/CESAR B PAULA/ Primary Examiner, Art Unit 2178
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5/13/2008